

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Rejection of Claims 22-25, 27, 29-32 and 34 Under 35 U.S.C. §103(a)

The Office Action rejects claims 22-25, 27, 29-32 and 34 under 35 U.S.C. §103(a) as being unpatentable over Ezzat et al. (Visual Speech Synthesis by Morphing Visemes) ("Ezzat et al.") in view of Jiang et al. (Visual Speech Analysis with Application to Mandarin Speech Training) ("Jiang et al.") in view of Cox et al. (Speech and language processing for next-millennium communications services) ("Cox et al."). Applicants submit an affidavit under 37 C.F.R. § 1.131 to establish reduction to practice before the August 2000 publication date of Cox et al. in Proceedings of the IEEE, Vol. 88, No. 8, and diligence until the filing date. A 37 C.F.R. § 1.131 affidavit may be used to antedate a reference that qualifies as prior art under 35 U.S.C. § 102(a). MPEP 715(I)(A). Here, Cox et al. qualifies as prior art under 35 U.S.C. § 102(a) because it was described in a printed publication in August 2000, before the present application's filing date of 29 March 2001. Therefore, the § 1.131 affidavit may be used.

Such an affidavit requires a showing of facts to establish an earlier priority date. Regarding the facts which much be shown in such an affidavit, 37 C.F.R. § 1.131(b) states

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Applicants will show facts of such character and weight to establish their reduction to practice prior to Cox et al. coupled with due diligence from that date.

In determining the sufficiency of a 37 C.F.R. § 1.131 affidavit, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). MPEP 715.07(a). This application claims priority to a parent application 2000-0042, filed 29 March 2001, now issued as U.S. Patent 6,654,018. Applicants conceived the idea of an audio-visual selection process for synthesizing photo-realistic talking head animations as described and claimed in our application at least as of January 1999, which is prior to the 29 March 2001 filing date of the parent application. Affidavit, paragraph 5. The Multimedia Intellectual Property Review (IPR) Team of AT&T Corp. approved IDS No. 2000-0042, the parent application of the instant application, on 17 March 2000. Affidavit, paragraph 7. Thomas Restaino, General Attorney of AT&T Corporate Affairs, or his secretary approved and signed IDS No. 2000-0042 and sent the disclosure to Ann Taylor, Outside Counsel Coordinator, on 4 April 2000 with instructions to assign the disclosure to outside counsel Wendy Koba to prepare and file the patent application. Affidavit, paragraph 8. AT&T Corp. mailed the disclosure to Wendy Koba. Wendy Koba mailed AT&T Corp. a two-sided receipt affirmatively indicating that she received the disclosure. AT&T Corp. received and datestamped the receipt on 12 April 2000. Affidavit, paragraph 9.

Under MPEP 2138.06, the period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). MPEP 715.07(a) states further under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Therefore, the time period in question which must be accounted for by affirmative

acts or acceptable excuses is the publication date of Cox et al. to the filing date of 2000-0042, or just before August 2000 to 29 March 2001, a period of approximately 8 months. Applicants affirmatively acted by submitting the invention for review to the IPR Team of AT&T and it was approved on 17 March 2000. The submission was assigned to outside counsel, Wendy Koba. Wendy Koba's acknowledgement of receipt of the assignment was datestamped by AT&T on 12 April 2000. Affidavit, paragraph 11.

The diligence of the attorney in preparing and filing patent application inures to the benefit of the inventor. MPEP 2138.06. The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937). MPEP 2138.06. Therefore, Applicants need only show diligence starting from a time just prior to August 2000 to 29 March 2001. The United States District Court for the Eastern District of Tennessee held that a 10-month delay in filing an 18-page application with only 9 claims was not reasonable diligence. *Mendenhall v. Astec Industries Inc.*, 13 USPQ2d 1913 (EDTn 1988). Another case holds that a 10-month delay can count as reasonable diligence with other work and litigation. *Poage v. Dyer*, 184 USPQ 223 (POBdInt 1974). The present application is 20 pages counting drawings, includes 21 claims, and took 11 months to prepare, meaning this application is longer, more detailed, and includes more claims than the application in Mendenhall. While the application took 11 months to prepare, Applicants are only required to show diligence for the final 8 months of that period. For example, suppose Wendy Koba could not begin working on the application up until July 30, 2000, and started working diligently to prepare and file the application starting on July 31, 2000. This scenario would be enough to

establish prior conception and diligence sufficient to swear behind Cox et al. Therefore, Wendy Koba prepared this application with reasonable diligence.

Applicants respectfully submit that the 37 C.F.R. § 1.131 affidavit establishes a prior date of invention before August 2000 and diligence from just before August 2000 to 29 March 2001. Because of the established prior date of invention and diligence, Cox et al. is not available as a prior art reference under 35 U.S.C. § 102(a) or § 103(a). Accordingly, Applicants submit that claims 22-25, 27, 29-32 and 34 are patentable and in condition for allowance and respectfully request that the rejection be withdrawn.

Rejection of Claims 28 and 35 Under 35 U.S.C. §103(a)

The Office Action rejects claims 28 and 35 under 35 U.S.C. §103(a) as being unpatentable over Ezzat et al. in view of Jiang et al. further in view of Cox et al. and further in view of Brand (Voice Puppetry) ("Brand"). Applicants submit that for the same reasons as explained above, Cox et al. is not available as prior art. Therefore, Applicants request that the rejection of claims 28 and 35 be withdrawn.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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